

Brands, Expressive Speech and Social Justice

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It is relatively uncommon to associate social justice with trade mark law. Most scholarship has explored the relationship between IP and social justice from the perspective of copyright and patents, but a lot less attention has been devoted to brands.¹ This paper maps the interface between social justice, expressive speech and source-identifying brands. It argues that the relentless commodification of brands as valuable economic assets in themselves and the normative description of trade marks as property rights in gross throws up profound implications for speech and social justice. The paper explores the role that brand protection can play in advancing social justice goals promoting inclusion, cultural participation, self-expression and tolerance that better serve the public good in the modern world. It will examine the limits of trade mark's internal devices in serving the expressive interests of individuals and marginalised groups, and the reasons why their interests *do* matter from a social justice perspective. It also will consider the role played by the First Amendment in promoting speech interests but will go beyond the existing literature and evaluate wider social justice concerns that hardly ever feature in the discussions. Parodies are perhaps the best of illustration of trade mark law's encroachment into free speech values. The paper will discuss potential incentives for brand owners in the use of their brands in public discourse, perhaps by demonstrating the positive effects of brand awareness and brand recognition after *post*-parody uses. It will conclude by offering potential ways in which modern trade mark law can perhaps be re-imagined and re-purposed bearing in mind wider societal values beyond private economic interests such as pluralism and inclusion.

Trade mark protection is generally accepted to exist to promote market transparency, by protecting producer interests in their investment around product quality and by reducing consumer search costs. Properly conceived, trade mark exclusivity is a necessary condition for preserving business reputation and improving consumer welfare, not as aims in themselves, but as the most effective means of promoting product competition. Given their effective communicative value, brands can quickly become more than mere source-identifiers and serve as symbols of cultural expression conveying a multitude of messages about race, class and society. When brands are used for expressive purposes, free speech concerns become implicated. In US law, this calls for greater First Amendment scrutiny. These are not however the only social justice concerns that may arise in trade mark disputes. Aggressive trade mark policing can also lead to social exclusion and marginalisation of societal groups. For instance, on both sides of the Atlantic, brand owners have been able to exclude LGBT organisations from conveying an effective message about awareness of the gay community and the travails of transgender people in developing countries. In 2006 the owner of the 'Miss World' registered mark persuaded the English High Court to injunct the broadcasting of a TV show under the name 'Mr Miss World' about the fortunes of an English competitor in a

1. Notable exceptions, see Peter Menell, 'Property, Intellectual Property, and Social Justice: Mapping the New Frontier' (2016) 5 Brigham-Kanner Property Rights Conference Journal 147, 182-186; Rosemary J Combe, Steven Schnoor and Mohsen Ahmed, 'Bearing Cultural Distinction: Informational Capitalism and New Expectations for Intellectual Property' (2007) 40 UC Davis 891 (discussing the role of geographical indications in promoting rural development)

beauty pageant for transvestites and transsexuals in Thailand.² Even though the proprietor conceded that the public might not be confused about the source of the TV show, the judge found a strong likelihood of dilution and/or unfair advantage in the sense of ‘trading upon the goodwill and repute of the [Miss World] mark in an unfair manner.’ Similarly, the owner of the mark ‘The Pink Panther’ succeeded in a preliminary injunction preventing a gay rights activist group using the name ‘Pink Panther Patrol’ and paw print design as part of their logo. The purpose of the Pink Panther Patrol was to patrol the streets of New York City as protection against the (then) rising violent attacks against gays. The District Court found likelihood of confusion in the sense that defendants’ use would cause consumers to wonder whether the comic Pink Panther mark owner was sponsoring the organisation’ cause and efforts.³ In both cases the courts found it unnecessary for the defendants to make cultural references to pink as a colour associated with gay activism or to ‘Miss World’ as an immediately recognisable shorthand for a beauty contest.

Branded products can also become status goods in the sense of enabling consumers to convey socially desirable characteristics and messages of exclusivity to others. Target consumers are prepared to pay a premium for these status goods. However, expansive trade mark infringement doctrines are also capable of producing social exclusion. Here again, we find similar examples on both sides of the Atlantic. In the infamous *L’Oreal v Bellure* saga, the English Court of Appeal (CA) was sceptical that Bellure’s sales of its smell-alike copies would result in confusion, dilution, unfair advantage or any harm to the essential function of several marks owned by L’Oreal. The CA noted the different markets and categories of consumers targeted by the parties. Bellure’s imitation copies were sold at ‘downmarkets’, retailing at £2-4 on a market stall compared to a typical L’Oreal fragrance which costs £60 or more retail. In the CA’s view, ‘consumers are not stupid’ as ‘[no one] thinks a replica is anything other than a cheap imitation of the original or is likely to be of the same quality of the original.’⁴ After referring several questions of interpretation to the Court of Justice of the European Union (CJEU),⁵ the CA reluctantly gave judgement for L’Oreal on the basis that the imitation copies enabled Bellure to take an unfair advantage of the luxury image of the branded fragrances. However, the CA was of the firm view that the CJEU’s ruling meant that traders were being ‘muzzled’ in violation of their free speech rights to make honest statements about their products.⁶ More recently, a NY District Court decided an almost identical dispute involving knockoff fragrances of claimant Coty’s high-quality fragrances. As in *Bellure*, defendant Excell decided to mimic the original fragrances to offer its customer base of lower income ethnic customers an imitation product easily understood as evoking the names of famous fragrances.⁷ The packaging of Excell’s cheap perfume versions also prominently displayed Coty’s own marks but with the words ‘Our own version of’ in smaller text. Unlikely the conception of consumers by the English CA, however, the District Court

2 *Miss World Ltd v Channel Four Television Corp*, [2006] EWHC 982 (Pat)

3 *MGM-Pathé Communications Co v The Pink Panther Patrol*, 774 F.Supp 869, 873 (SDNY, 1991)

4 *L’Oreal v Bellure*, [2007] EWCA Civ 968, at [7] (CA)

5 *L’Oreal v Bellure* (C-487/07) ECLI:EU:C:2009:378

6 *L’Oreal v Bellure*, [2010] EWCA Civ 535, at [7] (CA)

7 *Coty Inc v Excell Brands*, 277 FSupp3d 425 (SDNY, 2017)

found that the less sophisticated Excell consumers would be more like to be confused upon seeing the cheaper perfumes. It thus found confusion, blurring, tarnishment and false advertising. Once again, in none of these cases did the courts comment upon the social justice implications of their decisions, namely that poor consumers are the real losers. The real thing is beyond their wildest dreams as they are denied the right to buy cheap imitations that would give them a bit of pleasure, in the same way that wealthier consumers derive pleasure from the luxury image and status of the famous fragrances. Strong brand protection can therefore exacerbate rather than reduce social inequalities.

The negative impact of the commodification of trade marks extends well beyond infringement contexts. We can observe profound social justice implications also at the registration stage, where trade mark law can be deployed as an attempt for perpetual appropriation of artworks and cultural signs. The European Free Trade Area (EFTA) Court recently issued an advisory opinion regarding the Oslo Municipality's applications to register several artworks by artist Gustav Vigeland as trade marks.⁸ The applications were filed upon copyright protection for the artworks expiring. In its reasoned opinion for the Board of Appeal at the Norwegian IPO, the EFTA Court interpreted European trade mark law as allowing for the possibility of refusing registration of a famous piece of art forming part of the universal cultural heritage on the basis of public policy or accepted principles morality. This (underexplored) exclusionary ground has been largely limited to scandalous or offensive marks.⁹ For the EFTA Court however the general interest in preserving the public domain and keeping unrestricted access to cultural signs for all required a broader interpretation of the morality and the public policy exclusions. In this case, trade mark registration may be seen by the public as 'misappropriation or desecration of the artist's work' if it is granted for goods/services that contradict the values/messages of the artist (immorality exclusion) or may be regarded as 'a serious threat to a fundamental interest of society (public policy exclusion). One of such fundamental interest is to safeguard the public domain against the perpetual monopolisation of artistic works that are part of a nation's cultural heritage, an emblem of sovereignty or of the nation's foundations. Another example of ownership claims over culturally significant signs is Lindt's attempts to register as an EU Trade Mark the trade dress of an Easter chocolate bunny. In support of its claims, Lindt has argued that certain product features (ie the sitting bunny, the golden foil and the little red bell and ribbon around the bunny's neck) confer sufficient distinctiveness upon the trade dress to be a source-identifying brand for chocolate consumers. The non-inherently distinctiveness objection was appealed to the CJEU, which confirmed the refusal.¹⁰ Given that a non-inherently distinctive mark may be registered after showing secondary meaning, Lindt made a second attempt before the EUIPO. This time however the Office applied aesthetic functionality as a basis for excluding the application based upon cultural misappropriation concerns. It reasoned that 'the Easter bunny is part of the folklore surrounding Easter' and the proposed shape was 'in itself the

8 *Municipality of Oslo* (E-5/16) (6th April 2017, EFTA). See: http://www.eftacourt.int/uploads/tx_nvcases/5_16_Judgment_EN.pdf

9 The CJEU has yet to give a ruling on the meaning and scope of these important exclusions and it seems that a pending appeal might represent the first opportunity to do so, see *Constantin Film Produktion GmbH v EUIPO* (C-240/18 P)

10 *Chocoladefabriken Lindt & Sprüngli AG v OHIM* (C-98/11 P) ECLI:EU:C:2012:307

essential element which determines the value of the chocolate goods.’¹¹ In both these cases, the framing of the refusal based upon public policy and aesthetic functionality masks social justice concerns that are seldom discussed openly in trade mark cases.

11 R-2450/2011 G *Chocoladefabriken Lindt & Sprüngli AG* (7th July 2017, Grand Chamber at EUIPO, unreported) at [37-38] R-2450/2011 G *Chocoladefabriken Lindt & Sprüngli AG* (7th July 2017, Grand Chamber at EUIPO, unreported) at [37-38]